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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,727	08/25/2003	Ren Jianchang	081203.P002	4713

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EXAMINER

FISHMAN, MARINA

ART UNIT

PAPER NUMBER

2832

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/648,727

Applicant(s)

JIANCHANG, REN

Examiner

Marina Fishman

Art Unit

2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,7,8,12,15,19,23,24,29,32 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7,8,12,15,19,23,24,29,32 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/27/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *General Status*

1. This is a First Action on the Merits. Claims 1, 2, 4, 7, 8, 12, 15, 19, 23, 24, 29, 32, 36 are pending in the case and are being examined.

### *Priority*

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Objections*

3. Claim 1 is objected to because of the following informalities: in line 11 "components" should be corrected as --component--; in line 12 "produces" should be corrected --produce--.

The Examiner has pointed out only few of the deficiencies, the Applicant is required to review all the claims and make necessary corrections.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 2, 4, 7, 8, 12, 15, 19, 23, 24, 29, 32, 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 8, it is unclear what is meant by "the magnetic field generating component and **component..**".

Claim 8, line 7, recites "a hole in the magnetic field generating component" it is unclear if Applicant introducing a new element or if Applicant is referring to the element introduced in Claim 1, line 5.

Claims 12, 19 and 36 depend from canceled claims 5, 3 and 35 respectively and therefore are vague and indefinite. For the purpose of examination Examiner has assumed that Claims 12, 19 and 36 depend from Claim 1.

Claim 12 recites the limitations "**the multi-layer** cylinder of the magnetic field ..." in lines 1 and 2, and "**the multi-layer** cylinder of the conductive component...". There are insufficient antecedent basis for these limitations in the claim.

Claim 15 recites the limitations "**the numbers of layers** of the magnetic field ..." in lines 1 and 2, and " **the numbers of layers** of the conductive component...". There are insufficient antecedent basis for these limitations in the claim.

Claim 36 recites the limitation "the soft magnetic material" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1, 2, 12, 15, 29, 32, 36, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Komuro et al. [US 5,557,083].

Komuro et al. disclose an integrated contact having:

- an arc proof component [12, 31, 41; Figures 3, 8 – 10];
- a conductive component and a magnetic field generating component, having a top and a bottom and a through hole extending from the top to the bottom [Figure 10];
- a container having a center and a top , wherein the arc proof component, the conductive component and the magnetic field generating component are set in the container, the magnetic field generating component and the conductive component are mutually combined and set inside of the container, and the arc proof component is set on top of the combination of the magnetic field generating component and the conductive component [Figures 1b, 3, 8 - 10], the combination of the magnetic field generating component and the conductive components are configured to produce an axial magnetic field [Column 13, lines 25 – 55].

Regarding Claim 2, Komuro et al. disclose the magnetic field generating component has a through oblique section from the top to the bottom at a side facing the center of container [Figure 10], with a magnetic path of the magnetic field generating component opened by a break [56, 58] from top to bottom, and the conductive component having a supporting oblique section coinciding with the corresponding oblique section of the magnetic field generating component.

Regarding Claims 12 and 15, Komuro et al. disclose the magnetic field generating component and the conductive component with the same number of layers [Figure 3].

Regarding Claim 29, Komuro et al. disclose the arc proof component is made of copper chromium alloy [Column 3, lines 50 - 55].

Regarding Claim 32, Komuro et al. disclose the conductive component made of copper powder [Column 12, lines 60, 61; Column 6, lines 8 - 21].

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 23 and 24, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Komuro et al. [US 5,557,083].

Regarding Claim 23, Komuro et al. disclose the instant claim invention except the container is made from rustles steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the container made from rustles steel, in order to prevent corrosion, since it has been held to within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice [In re Leshin, 125 USPQ 416].

Regarding Claim 24, Komuro et al. disclose the arc proof component is

a mixture of copper powder and chromium powder [Columns 3 - 10], however do not specify the exact ration of the copper powder and chromium powder as recited in the claim. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the ration of the copper powder and chromium powder from 10:90 to 90:10, in order to improve the reliability of the arc proof component, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art [In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)].

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1, 2, 4, 7, 8, 12, 15, 19, 24, 29, 32, 36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 6, 10, 11, 13, 14, 17, 21, 24, 28 of copending Application No. 10/648,607. Although the conflicting claims are not identical, they are not patentably distinct from each other because the all limitations recited in Claims 1, 2, 4, 7, 8, 12, 15, 19, 24, 29, 32, 36 of the instant Application are substantially the same as all limitations

Art Unit: 2832

recited in Claims 1, 2, 5, 6, 10, 11, 13, 14, 17, 21, 24, 28 of copending Application No. 10/648,607. All the elements and limitations recited in claims of the instant application are found in the various claims of the copending Application, such that combining them in different combinations would have been obvious in order to form product having the various different named elements with the same functions, or perhaps to vary the scope of the claims to avoid infringement or capture infringers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gorman et al. [US 4,117,288], Hess et al. [US 4,935,588], Schels et al. [US 5,055,639], Mayo [US 5,777,287] all disclosed contact arrangements.

Applicant also should consider these references in response to this office action.

Should issue arise concerning the rejection presented above, these references may be relied upon in a subsequent action to support the lack of novelty or obviousness of claimed subject matter to one of ordinary skill in the art.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Fishman whose telephone number is 571-272-1991. The examiner can normally be reached on 7-5 M-T.

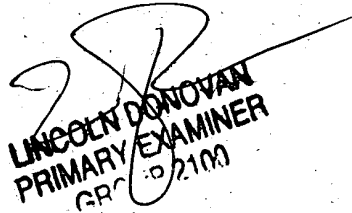
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 2832

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Fishman  
April 28, 2004

  
LINCOLN DONOVAN  
PRIMARY EXAMINER  
GPO 2103